

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 02-1445.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 02-1445.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants wish to thank Examiner Robinson for the courtesy of the interview recently accorded Dr. Linkenheil and the undersigned, who are both Applicants' representatives.

Claims 15 and 19 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants submit that the cancellation of claims 15 and 19 moots this rejection.

Claims 12-19 were rejected under obvious over Schaub, U.S. Patent No. 4,849,439, in view of Ludwig et al. ("Ludwig"), U.S. Patent No. 5,200,421, and European Patent No. 0 393 846. In response, Applicants note that during the

interview the Examiner indicated that upon the filing of this response the prosecution of this application would be suspended pending a possible interference with an application allowed, but not yet issued. Applicants submit that if there is interfering subject matter that has been allowed in another application, then that subject matter is allowable here as well.

Further, Applicants again disagree with the Examiner's finding that the Martin Declarations are insufficient to overcome the rejection because the compound employed in the instant method is an old fungicide, and has previously been employed against "the same type of fungi." At other points in the Office Action, the Examiner states that Schaub discloses the compound employed in the instant method is effective against fungi "in the same class." While the latter point is technically accurate, the former is not, and does not follow from the latter point.

In this regard, Schaub teaches that cyproconazole, among other compounds, is effective against phytopathogenic fungi of the classes Basidiomycetes, Ascomycetes and Deuteromycetes. While it is true that the instant specification mentions these same classes, for example, at pages 3-5, the instant method is drawn to the use of cyproconazole against wood-discoloring or wood-destroying fungi of these classes. Applicants previously argued, but the Examiner did not comment, that, for example, among the Basidiomycetes the phytopathogenic fungi and the wood-destroying fungi belonged to different subclasses. See page 3 of the amendment dated July 10, 1996, and the attachments thereto. Consequently, there is no reason to believe that because Schaub teaches cyproconazole is effective against

phytopathogenic fungi of Basidiomycetes, for example, this is the same as teaching cyproconazole is effective also against wood-discoloring or wood-destroying fungi of Basidiomycetes. The two sets of activities are distinct from each other, and the fungi which cause diseases to plants are distinct from those that discolor or destroy wood. Accordingly, a person of ordinary skill in the art would not, in fact, have been motivated by the teachings of Schaub to use cyproconazole to protect wood from wood-discoloring or wood-destroying fungi.

The foregoing is further supported by the Kugler Declarations filed September 19, 1995, and October 17, 1994, which both show that extrapolation from effectiveness against phytopathogenic fungi to effectiveness against wood-discoloring or wood-destroying fungi is improper and unfair. Thus, both declarations presented a series of comparisons involving azole fungicides shown to be effective against phytopathogenic fungi. Whereas all of the tested compounds were effective against phytopathogenic fungi, only cyproconazole was effective to protect wood from wood-discoloring or wood-destroying fungi. These declarations, thus, prove that although a compound is known in the prior art to be effective against phytopathogenic fungi, this did not teach or suggest similar effectiveness against wood-discoloring or wood-destroying fungi. Quite the contrary, the data suggest that the greater likelihood is that a given compound that was effective against phytopathogenic fungi would not be useful against wood-discoloring or wood-destroying fungi. Accordingly, again, it cannot be concluded from Schaub that a person of ordinary skill in the art would have been motivated by the teachings of Schaub to use cyproconazole to protect wood from wood-discoloring or wood-

destroying fungi.

Applicants are mindful that the Examiner relies on two secondary references. The Examiner comments that these secondary references teach similar triazoles are effective against wood fungi, and therefore a person of ordinary skill in the art would have been motivated to use cyproconazole to protect wood from wood-discoloring or wood-destroying fungi. In response, Applicants point out that EP 0 393 746 relates to a specific synergistic combination of tebuconazole and propiconazole. Likewise, Ludwig relates to specific synergistic combinations of certain azole fungicides, including tebuconazole, and iodopropargyl derivatives, such as IPBC; among the azole derivatives, cyproconazole does not appear to be mentioned. Because of the very specific nature of the teachings of these references, Applicants submit that a person skilled in the art would not, in fact, have been led by these references to use cyproconazole to protect wood from wood-discoloring or wood-destroying fungi with a reasonable expectation of success.

Moreover, the Examiner is on record in the very first Office Action in this series of application, i.e., the Office Action mailed February 15, 1994, as finding that the various active ingredients and/or synergistic combinations are patentably distinct one from the other, and that a reference against one would not be a reference against any of the other under 35 USC § 103. Applicants respectfully submit that the Examiner, once having taken that position, cannot look to references to patentably distinct active ingredients and/or synergistic combinations for teachings or suggestions how cyproconazole might be used.

Consequently, neither the primary reference nor any proper combination thereof with the secondary references leads to the conclusion that the use of cyproconazole to protect wood from wood-discoloring or wood-destroying fungi would have been obvious at the time the present invention was made.

Even assuming for the sake of argument that the cited combination of references did establish the present invention to be prima facie obvious, the Kugler Declaration discussed above, and the Kugler Declaration filed April 6, 1995, all establish that cyproconazole is superior in the protection of wood against wood-discoloring and wood-destroying fungi to other azole fungicides. Since protection of wood against wood-discoloring and wood-destroying fungi is of great economic importance, these declarations establish a realm of specific usefulness where cyproconazole will be especially useful where other azole fungicides will not. Because there is absolutely nothing in the cited prior art that teaches or suggests that cyproconazole would show superior usefulness for this purpose, these results must be considered to be surprising and unexpected, and therefore objective evidence of nonobviousness.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Applicants believe the foregoing constitutes a full and complete response to all outstanding objections and rejections.

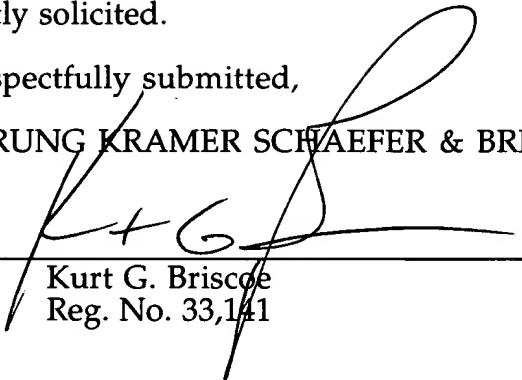
LUTZ HEUER ET AL.
USSN 08/888,609

Early and favorable action is earnestly solicited.

Respectfully submitted,

SPRUNG KRAMER SCHAEFER & BRISCOE

By


Kurt G. Briscoe
Reg. No. 33,141

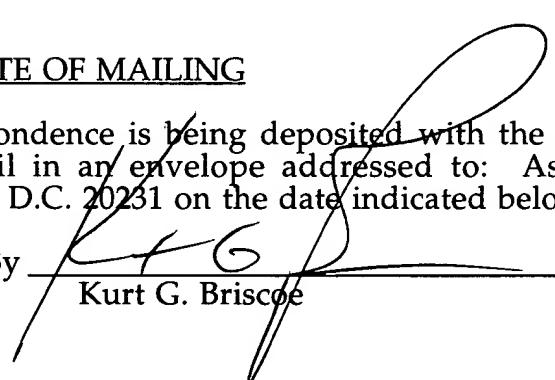
660 White Plains Road
Fourth Floor
Tarrytown, New York 10591-5144
(914) 332-1700

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on the date indicated below:

Date December 7, 1998

By


Kurt G. Briscoe